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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,353	09/12/2000	John A. Arbuckle	0457-PCT-US	4766

7590

12/17/2002

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EXAMINER

TUNG, JOYCE

ART UNIT

PAPER NUMBER

1637

DATE MAILED: 12/17/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/622,353

Applicant(s)  
Arbuckle et al.

Examiner  
Joyce Tung

Art Unit  
1637



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 8, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 1637

***Response to Amendment***

1. The amendment filed 10/8/2002 has been entered.
2. The rejection of claim 2 under 35 U.S.C. §112, second paragraph is withdrawn.
3. Claims 1, 4-7, 9-13 and 15-21 remain rejected under 35 U.S.C. §103(a) as being unpatentable over Briggs et al. (5,962,764) in view of Lindemann et al. (5,958,738).

Applicant's arguments filed 10/8/2002 have been fully considered but they are not persuasive because Applicants argue that in Briggs et al. one can determine an otherwise unknown phenotype for a gene of known sequence, while the claimed invention enables one to isolate an unknown sequence given a known phenotype and Briggs et al. employ primers to the transposable element and to the known genetic sequence. The limitation "isolate an unknown sequence given a known phenotype" is not in the claim language. However, if the claim is amended to include the limitations as discussed in the response filed 10/8/2002 with due support in the specification, the instant rejection will be withdrawn.

Applicants further argue that Briggs et al. do not disclose using primers to anneal to the adapter and transposable element and Lindemann et al. also do not disclose using primers to anneal to the adapter and transposable element. However, in the claims, there are two primers in which one of the primers anneals to the adapter sequence and the another primer anneals to the transposable element. Accordingly, Applicants arguments are not commensurate with the scope of the claimed invention.

Art Unit: 1637

Applicants also argue that Lindemann et al. teach a method for obtaining polynucleotides comprising sequences that differ between two populations of DNA. It appears that the claimed invention uses two populations of DNA that differs in the sequences (See claim 1, step(b)).

Thus, the rejection is maintained.

Regarding the request in the response filed April 11, 2002 that examiner detail for record why the inoperability of Lindemann et al. as modified for the claimed invention fails to disqualify it as prior art. It is unclear what is meant by disqualifying as prior art and its inoperability. However, the reference of Lindemann et al.'s filing date is March 24, 1997 which is before the priority date claimed, 2/17/1998. In addition, the reference of Lindemann et al. was applied with the reference of Straus et al. under 35 U.S.C. 103(a) in the rejection mailed 6/21/2001 and the rejection was withdrawn. All US patents are operable.

4. Claims 2-3, 8 and 14 remain rejected under 35 U.S.C. 103(a) over Briggs et al. and Lindemann et al., further in view of Schanble et al. and Halverson et al.

Since claims 2-3, 8 and 14 depend from claim 1 which is not allowable over the prior art as discussed in section 3 above. the rejection of claims 2-3, 8 and 14 is maintained.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 1637

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

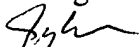
6. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

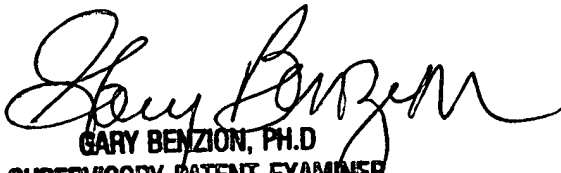
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119 on Monday-Friday from 10:00 AM-6:00 PM.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

7. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1637 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

  
December 11, 2002

  
GARY BENZION, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600